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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,288	06/01/2005	Bertrand Piot	271640US0PCT	1851
22850	7590	10/03/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GEORGE, KONATA M	
			ART UNIT	PAPER NUMBER
			1616	
			NOTIFICATION DATE	DELIVERY MODE
			10/03/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/537,288

Applicant(s)

PIOT, BERTRAND

Examiner

Konata M. George

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-40, 43-47 and 49-52 is/are rejected.
- 7) ☒ Claim(s) 41, 42 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/25/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 19-52 are pending in this application.

#### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on April 25, 2007 was noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

#### ***Action Summary***

2. The rejection of claims 19-21, 23-30, 40-47 and 49 under 35 U.S.C. 102(b) as being anticipated by Ajinomoto Co. Inc. is hereby withdrawn in view of applicants amendment to the claims.
3. The rejection of claims 19-21, 23-32, 36-39, 41, 42, 48 and 49 under 35 U.S.C. 103(a) as being unpatentable over Ajinomoto Co. Inc. is being maintained for the reasons stated in the office action dated March 39, 2007.
4. The rejection of claims 40 and 43-47 under 35 U.S.C. 103(a) as being unpatentable over Ajinomoto Co. Inc. is being maintained for the reasons stated in the office action dated March 39, 2007.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 40 and 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ajinomoto Co. Inc. (EP 0 538 764 A1).

***Determination of the scope and content of the prior art***

**(MPEP §2141.01)**

Ajinomoto Co. Inc. discloses in Table 6, page 8, a composition comprising a physiologically acceptable medium (36.95% of pure water), at least one alkyl para-hydroxybenzoate (ethyl and propyl para-hydroxybenzoate 0.03% and 0.02% respectively), and at least one lipophilic amino acid derivative (5.0 % of ester D as defined as N-lauroyl-N-methyl- $\beta$ -alanine as described in preparation example 4, page

5). It is taught that after components 1 and 2 were mixed a powder of adrenocortical hormone was added.

***Ascertainment of the difference between the prior art and the claims***

**(MPEP §2141.02)**

Ajinomoto Co. Inc. does not teach use of a wax in the composition or the concentrations of the particles.

***Finding of prima facie obviousness***

***Rational and Motivation (MPEP §2142-2143)***

Although Ajinomoto Co. Inc. does not teach the use of waxes in the composition by way of an example, the specification teaches that waxes can be used. Page 3, lines 19-24 of Ajinomoto teaches a group of compounds that can be used as a substitute for an oily base, such as animal and vegetable oils, waxes (beeswax or carnauba wax), mineral oil, silicone oils, vaseline, synthetic oils, etc. It is the position of the examiner that all of the compounds listed could be used interchangeably with a reasonable expectation of achieving the same results. Since, table 6 teaches that Vaseline can be incorporated into the composition, one of ordinary skill in the art would have been motivated to substitute a wax for the Vaseline in the preparation to achieve the desired results of the composition. Table 7 teaches that the drug can be added ad lib to the O/W emulsion base. It is the position of the examiner that adding the drug ad lib allows one of ordinary skill in the art to add as little or as much of the powdered drug necessary to elicit a response of the drug.

***Response to Arguments***

6. Applicant's arguments filed June 29, 2007 have been fully considered but they are not persuasive.

Applicant argues that Ajinomoto Co. Inc. does not teach the ratio of the alkyl para-hydroxybenzoate to lipophilic amino acid derivative as claimed. The examiner disagrees. Claims 40 and 43-47 do not teach any ratios for the alkyl para-hydroxybenzoate and lipophilic amino acid derivative, they are directed to process claims. It is the position of the examiner that Ajinomoto Co. Inc. teaches the process as claimed. Claim 40 is directed to by mixing the alkyl para-hydroxybenzoate with the lipophilic amino acid derivative. Table 6 teaches mixing the alkyl para-hydroxybenzoate with the lipophilic amino acid derivative during its formulation.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 19-39 and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants in the claims recite the phrase "derivatives". Webster's Dictionary defines a derivative as "a substance derived from, or of such composition and properties, that it may be considered as derived from, another substance by chemical change, esp. by the substitution of one or more elements or radicals". Based on this definition it is unclear what the derivative is.

***Allowable Subject Matter***

8. Claims 41, 42 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Ajinomoto Co. Inc. does not teach, suggest or make obvious the ration of the alkyl para-hydroxybenzoate to lipophilic amino acid derivative as claimed in claims 41 and 42. Ajinomoto Co. Inc. also does not teach, suggest, or make obvious the solid particles of claims 43 selected from the group consisting of synthetic mineral fibers, natural mineral fibers, synthetic organic fibers, natural organic fibers and wax dispersions.

***Conclusion***

9. Claims 19-40, 43-47 and 49-52 are rejected.

***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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